

REMARKS

In response to the Office Action mailed October 28, 2008, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1, 3-12, 18, 20-29, 35, 37-46, 52-54, 56-57, 59, 61-62, 64, 66-67 and 69-75 were previously pending in this application. Claims 1, 3-23, 70-72 and 74 are canceled. Claims 18, 26-29, 35, 42-46, 52-54, 61-62, 66, 73 and 75 are amended herein. No claims are added. As a result, claims 18, 20-29, 35, 37-46, 52-54, 61-64, 66-67, 69, 73 and 75 are pending for examination, with claims 1, 18, 35, 52, 53 and 54 being independent. No new matter has been added.

Claim Rejections Under 35 U.S.C. §101

Claims 1, 3-12 and 70-71 are rejected under 35 U.S.C. §101 for purportedly being directed to non-statutory subject matter. While Applicant does not concede the propriety of this rejection, claims 1, 3-12 and 70-71 are canceled, rendering the rejection moot.

Claim Rejections Under 35 U.S.C. §103

Independent claims 1, 18, 35, 52, 53 and 54 are rejected under 35 U.S.C. §103(a) as purportedly being obvious over commonly assigned U.S. Patent No. 6,122,635 to Burakoff et al. ("Burakoff") in view of U.S. Patent Publication No. 2002/0107847 to Johnson ("Johnson"). Without acceding to the propriety of the rejection, each of independent claims 1, 18, 35, 52, 53 and 54 is amended herein to more clearly distinguish over any combination of the asserted references.

A. Brief Overview Of Embodiments Of The Invention

Embodiments of the invention relate generally to providing access to a particular data element at a source location within an item of compliance information. The sections that follow describe compliance information and provide an overview of the embodiments of the invention.

1. Background

Applicant's specification discloses that securities exchanges and regulatory agencies require issuers of securities, such as mutual funds, to make certain information about a security available to potential investors before the security may be sold (p. 1, lines 17-18). This information is known as "compliance information." The Burakoff reference, which is commonly assigned and incorporated by reference in Applicant's application, describes compliance information, and draws a distinction between compliance information and "securities information":

Compliance information is certain information about a security that a government or a stock exchange requires be made available or delivered to an investor in that security. For example, the United States Securities and Exchange Commission ("SEC") and the National Association of Securities Dealers ("NASD") each require filing of certain information by an issuer of securities, this is an example of securities information. The SEC and NASD require that a certain subset of the securities information be made available to an investor in a security – this is compliance information[.]

Burakoff also discloses that securities issuers have recently been allowed to make securities information available to investors electronically, and that the Electronic Data Gathering, Analysis, and Retrieval (EDGAR) system maintained by the U.S. Securities and Exchange Commission (SEC) stores securities documents filed by securities issuers, so that these documents may be made publicly accessible to investors via the Internet (p. 1, lines 25-27). However, one drawback with EDGAR is that the documents are not stored in a way that allows investors to be able to quickly locate all information for a particular security (p. 1, lines 31-32). For example, there may be numerous filings for a particular security, as well as amendments, supplements, corrections, etc. for each (p. 2, lines 2-4). Also, each filing may include information on more than one security (p. 2,

lines 2-4), so that an investor looking for all relevant information for a security may have to review, parse and reconcile numerous filings (p. 2, lines 6-7).

Burakoff discloses a system which resolves many of the issues outlined above, by processing securities documents to identify compliance information, extract it and make it accessible to users (see, e.g., col. 2, lines 38-51).

2. Some Embodiments Of The Invention Take As Input An Item Of Compliance Information Produced As Output By The System Of Burakoff

Applicant has appreciated that while the Burakoff system provides a useful function in identifying items of compliance information, also of value may be the ability to “back-track” to those items in their original form. For example, a user looking at a web page that includes a representation of data elements included in an item of compliance information may wish to be able to verify the accuracy of a data element in the representation, or view more detail relating to the data element, by back-tracking to a portion of the item of compliance information in which the data element was originally presented (p. 2, lines 18-22). For example, a user viewing a web page showing data on fees charged by a mutual fund may wish to back-track to a filing by the issuer of the mutual fund to EDGAR in which the fee structure was explained, so as to determine whether a particular discount applies to the user (p. 2, lines 22-25).

Embodiments of the present invention provide this capability, by identifying, through the execution of programmed instructions, a source location within an item of compliance information at which a particular data element is located (p. 2, lines 15-18). An indication of the source location is stored, and is later used to retrieve the data element (p. 5, lines 18-19). For example, a user or programmed procedure may issue a request to access the data element at the source location, and the indication of the source location may be employed to retrieve it (p. 2, lines 22-25).

The foregoing summary is provided to assist the Examiner in appreciating some aspects of the invention. However, this summary does not necessarily apply to each independent claim, and the language of each independent claim may differ in material respects from the examples described above. Thus, Applicant respectfully requests that the Examiner give careful consideration to the

language of each independent claim and to address each on its own merits, without relying on the summary above. In this respect, Applicant does not rely upon the foregoing to distinguish any claim over the prior art, but rather relies only upon the remarks below.

B. Independent Claims 1, 18 and 35

As amended herein, each of independent claims 1, 18 and 35 includes limitations directed to identifying a source location containing a particular data element within an item of compliance information. The identifying comprises employing at least one parameter relating to the data elements appearance within the item of compliance information. An indication of the source location and a representation of the data element is stored. A representation of the data element is presented to a user, in a data structure other than the item of compliance information, in a manner that visually informs the user that the data element may be retrieved at the source location. A request is received from the user to retrieve the data element at the source location, and the indication of the source location is employed to retrieve the data element at the source location.

Each of claims 1, 18 and 35 patentably distinguishes over any combination of the asserted references, as neither Burakoff nor Johnson says anything at all about identifying a source location containing a particular data element *within an item of compliance information*.

At a fundamental level, the system of Burakoff is directed to identifying individual items of compliance information from among securities information (e.g., filed with EDGAR). The system produces output in the form of a computer-readable file which includes items of compliance information (see, e.g., col. 9, lines 20-23). Burakoff says nothing at all relating to identifying, within the item(s) of compliance information, a source location containing a particular data element, as required by each of independent claims 1, 18 and 35.

Johnson fails to remedy this deficiency of Burakoff, as Johnson says nothing at all relating to identifying a source location containing a particular data element within an item of compliance information. Rather, Johnson discloses a “visual” internet search engine (Abstract). The system of Johnson retrieves HTML documents from the internet and scans them for representative non-textual

content, such as images or audio files (Abstract). This representative non-textual content is stored in a database, and is presented to the user in response to queries that return the associated pages as results (see, e.g., FIG. 10).

Because neither Burakoff nor Johnson disclose or suggest identifying a source location containing a particular data element within an item of compliance information, each of claims 1, 18 and 35 patentably distinguishes over any combination of Burakoff and Johnson. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 18 and 35, and of the claims that depend respectively therefrom, under 35 U.S.C. §103(a) as purportedly being obvious over Burakoff in view of Johnson.

C. Claims 52, 53 and 54

As amended herein, each of independent claims 52, 53 and 54 includes limitations directed to receiving a request from a user to access at least one data element at a source location comprising at least a portion of an item of compliance information containing the at least one data element. The source location is identified via an execution of a set of programmed instructions which employs at least one parameter relating to the data elements appearance within the item of compliance information.

It should be appreciated from the discussion above relating to independent claims 1, 18 and 35 that neither Burakoff nor Johnson discloses or suggests receiving a request to access at least one data element at a source location comprising a portion of an item of compliance information, or executing a set of programmed instructions employing at least one parameter relating to the data element's appearance within the item of compliance information, as required by each of claims 52, 53 and 54. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 52, 53 and 54 under 35 U.S.C. §103(a) as purportedly being obvious over Burakoff in view of Johnson.


CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0389.70009US01.

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Respectfully submitted,

By 

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